

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

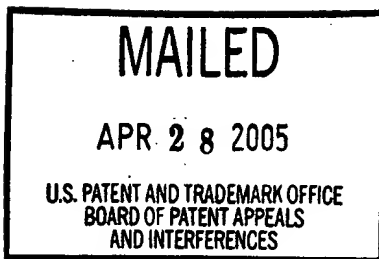
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte DAVID A. HAMMOND

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Appeal No. 2005-1023  
Application No. 09/963,734

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ON BRIEF

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Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 10, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates in general to first aid kits and, in particular, to a first aid kit which is adaptable to a plurality of first aid environments (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Campiglia	2,324,194	July 13, 1943
First Responder Kits #1 - #6 (First Responder) National Safety Council "First Aid Guide"		

Claims 1 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Campiglia in view of First Responder and the "First Aid Guide."

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed June 15, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed March 26, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 10 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that the applied prior art does not suggest the claimed subject matter absent the use of hindsight knowledge derived from the appellant's own disclosure.<sup>1</sup> We agree.

All the claims under appeal require arranging a plurality of first aid packs in a card catalogue/file cabinet-like array in particular order. Independent claims 1 and 10 require the packs to be arranged in the order of: a breathing first aid pack, a bleeding first aid pack, a shock first aid pack, a head and spine first aid pack, a bone first aid pack, a burn first aid pack, and then a bites and stings first aid pack. Independent claim 8 requires that the pack for the management of the most serious first aid situation be placed in a front compartment of the first aid kit and arranging the remaining packs in an order of descending seriousness in the first aid kit behind the pack for the management of the most serious first aid situation. However, these limitations are not taught or suggested by the applied prior art. To supply this omission in the teachings of the applied prior art, the examiner made a determination (answer, pages 3-5) that these differences would have been obvious to an artisan. However, this determination has

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<sup>1</sup> The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

not been supported by any evidence<sup>2</sup> that would have led an artisan to arrive at the claimed invention. In our view, there is no suggestion in the applied prior art for modifying Campiglia in the manner proposed by the examiner to meet the above-noted limitations.

The examiner is correct that it would have been obvious to an artisan to take emergency priorities into account when arranging the items being placed into Compiglia's three large vertically disposed pockets formed by partitions 12 and 14. However, this still does not suggest the claimed arrangement of first aid packs. To deal with this shortfall in the rejection, the examiner dismisses the claimed arrangement of first aid packs by stating that

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

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<sup>2</sup> Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The claimed arrangement of first aid packs as set forth in independent claims 1, 8 and 10 is not a recitation of the intended use but a specific structural arrangement of first aid packs. Thus, the mere fact that the prior art first aid packs are capable of being arranged in the manner claimed is not sufficient to defeat patentability.<sup>3</sup> The examiner must supply evidence establishing the obviousness of the claimed arrangement of first aid packs. Additionally, we do not agree with the position set forth by the examiner that the cases of *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963) support the proposition that in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Under 35 U.S.C. § 103 all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, it is well established that the materials on which a process is carried out must be accorded weight in determining the obviousness of that process. See *In re Pleuddemann*, 910

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<sup>3</sup> We note that the prior art applied by the examiner does not teach or suggest either a breathing first aid pack or a bites and stings first aid pack as recited in independent claims 1 and 10.

F.2d 823, 825-28, 15 USPQ2d 1738, 1740-42 (Fed. Cir. 1990); In re Kuehl, 475 F.2d 658, 664-65, 177 USPQ 250, 255 (CCPA 1973); Ex parte Leonard, 187 USPQ 122, 124 (Bd. App. 1974). In our view, the case law clearly establishes that the position of the examiner in this case is in error.

For the reasons set forth above, the decision of the examiner to reject independent claims 1, 8 and 10, and claims 2 to 7 and 9 dependent thereon, under 35 U.S.C. § 103 is reversed.

To summarize, the decision of the examiner to reject claims 1 to 10 under 35 U.S.C. § 103 is reversed.

Charles E. Frankfort

*Jeffrey V. Nase*  
JEFFREY V. NASE

  
JENNIFER D. BAHR

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GARDNER CARTON & DOUGLAS LLP  
ATTN: PATENT DOCKET DEPT.  
191 N. WACKER DRIVE, SUITE 3700  
CHICAGO, IL 60606

JVN/jg